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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,518	09/17/2003	Theodore B. Shockley	35481-73372	4878

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INDIANAPOLIS, IN 46204

EXAMINER
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CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/664,518	<b>Applicant(s)</b> SHOCKLEY, THEODORE B.	
	<b>Examiner</b> Monica S. Carter	<b>Art Unit</b> 3722	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 10-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Submission of Prior Art (ASPA) in view of Friesch (5,489,453) and further in view of Takeda et al. (3,963,821).

ASPA discloses a plurality of tickets comprising a sheet of stock paper having perforations defining detachable tickets therebetween (as seen Fig. 1, Prior Art).

ASPA discloses the claimed invention except for the substrate having a caliper characteristic between 5 and 8 points.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

ASPA, as modified by Friesch, discloses the claimed invention except for the claimed opacity characteristic of less than 98%.

Takeda et al. disclose synthetic paper substrates having an opacity value of 97% (which is less than 98%). Therefore, it would have been obvious to one having ordinary

skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Regarding claims 2 and 16, ASPA, as modified by Friesch and Takeda et al., discloses the claimed invention except for the claimed number of tickets on the roll being 1000 or 2000. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required number of tickets on the roll, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding claims 3, 15 and 17, ASPA, as modified by Friesch and Takeda et al., discloses the claimed invention except for the diameter of the roll being less than 4.5 inches or 6.5 inches. It would have been an obvious matter of design choice to provide any required dimension for the diameter of the roll, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding the stock paper being reply card stock paper (claims 4 and 13), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the stock paper disclosed in Fig. 1, Prior Art is capable of performing the intended use of being reply card stock paper.

Regarding claims 5, 10, 11, 12 and 18, see the above rejections to claim 1.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over ASPA in view of Friesch.

ASPA discloses a plurality of tickets comprising a sheet of stock paper having perforations defining detachable tickets therebetween (as seen Fig. 1, Prior Art).

ASPA discloses the claimed invention except for the substrate having a caliper characteristic between 5 and 8 points.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

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4. Claims 1-5, 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin, Jr. ('201) in view of Friesch and further in view of Takeda et al.

Austin, Jr. discloses a tube (26) and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see col. 1, lines 67-68 through col. 2 lines 1-2).

Austin, Jr. discloses the claimed invention except for the range of the caliper characteristic being between 5 and 8.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by Austin, Jr. with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

Austin, Jr., as modified by Friesch, discloses the claimed invention except for the claimed opacity characteristic of less than 98%.

Takeda et al. disclose synthetic paper substrates having an opacity value of 97% (which is less than 98%). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by Austin, Jr. with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Regarding claims 2 and 16, Austin, Jr., as modified by Friesch and Takeda et al., discloses the claimed invention except for the claimed number of tickets on the roll

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being 1000 or 2000. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required number of tickets on the roll, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding claims 3, 15 and 17, Austin, Jr., as modified by Friesch and Takeda et al., discloses the claimed invention except for the diameter of the roll being less than 4.5 inches or 6.5 inches. It would have been an obvious matter of design choice to provide any required dimension for the diameter of the roll, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding the stock paper being reply card stock paper (claims 4 and 13), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458,

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459 (CCPA 1963). In this case, the stock paper disclosed in Fig. 1; Prior Art is capable of performing the intended use of being reply card stock paper.

Regarding claims 5, 10, 11, 12 and 18, see the above rejections to claim 1.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Austin, Jr. in view of Friesch.

Austin, Jr. discloses a tube (26) and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see col. 1, lines 67-68 through col. 2 lines 1-2).

Austin, Jr. discloses the claimed invention except for the range of the caliper characteristic being between 5 and 8.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by Austin, Jr. with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

6. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over London in view of Takeda et al.



London discloses a plurality of tickets comprising a strip of stock paper having perforations defining detachable tickets therebetween, the strip being folded along at least some of the perforations to form a deck of tickets (as seen in figure 1).

Regarding the stock paper being reply card stock paper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the stock paper disclosed in London is capable of performing the intended use of being reply card stock paper.

London discloses the claimed invention except for the claimed opacity characteristic of less than 98%.

Takeda et al. disclose synthetic paper substrates having an opacity value of 97% (which is less than 98%). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by London with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Regarding claim 23, London discloses each ticket being marked with a serial number (see col. 1, lines 8-12).

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7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over London in view of Takeda et al. and further in view of Friesch.

London, as modified by Takeda et al., discloses the claimed invention except for the caliper characteristic being in the range of 5 to 8 points.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by London with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

### ***Response to Arguments***

8. Applicant's arguments filed October 4, 2004 have been fully considered but they are not persuasive.

Applicant argues that the cited prior art fail to disclose the claimed caliper characteristics and opacity values. The examiner asserts that while the cited prior art fail to explicitly disclose the claimed caliper characteristics and opacity values, newly cited references Friesch and Landoll disclose the claimed dimensions as set forth in the above rejections.

For the reasons as set forth above, the rejections are maintained.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 28, 2005

*Monica S. Carter*  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**